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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,972	11/26/1999	MINORU HAYASAKI	35.G2502	6961

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EXAMINER
VIDA, MELANIE M

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/449,972	HAYASAKI, MINORU
	Examiner	Art Unit
	Melanie M Vida	2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *15-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the following communications: amendment A filed on

11/24/03.

2.   This application has been reconsidered. The applicant cancels claims 1-14 and newly

adds claims 15-30.

Election/Restrictions

3.   Newly submitted claims 15-30 are directed to an invention that is independent or distinct

from the invention originally claimed for the following reasons: Claims 15 and 24 disclose an

image processing apparatus and method, respectively that comprise a receiving means for

receiving image information, storage means for storing the image information, an output means

for outputting the image information, and a controlling means to control the storage retention

based in image information that is output. These are distinct to the originally presented,

independent claims 1, and 8. Further, claims 22, and 29 disclose an image processing apparatus

and method, respectively that comprises a determining means to determine an output mode, a

conversion means to format image data, and a transmitting means to transmit the converted

image data. These are distinct to claims 6, 13, of the originally presented, independent claims.

Since applicant has received an action on the merits for the originally presented

invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 15-30 are withdrawn from consideration as being directed to

a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   **Claim 1** is rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claim 1 of U.S. Patent No. 5,777,617. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the

image processing apparatus in the application has similar means to the data output apparatus in

the patent, (col. 7, lines 50-55). For instance, the application claims a receiving means for

receiving image information, which reads on the means that "receives code data from an external

apparatus, and generates image data from the received code data", (col. 7, lines 51-54). Further,

the storage means for storing image information received by said receiving means in the

application, reads on a means for an "input buffer means for storing the received code data",

(col. 7, lines 55-56). The discriminating means for discriminating among modes used when the

image information is output by said output means", reads on a "determination means for

determining in which one of a plurality of output modes including the first and second modes

said data output apparatus is set", (col. 7, lines 62-65). Finally, the "control means, in which after

the image information is output by said output means in accordance with discrimination by said

discriminating means, said control means performs control so that the image information output

by said output means is not stored in said storage means", reads on the "control means for, when

said determination means determines that said data output apparatus is set in the first mode,

controlling said intermediate buffer means and said output buffer means such that the image

generated at a first size designated by the external apparatus from the intermediate data stored in

said intermediate buffer means is stored in said output buffer means and the generated image

data is sent from said output buffer means to an output section of said data output apparatus and

thereafter the stored intermediate data is deleted from said intermediate buffer means", (col. 7,

line 66 through col. 8, line 9).

5.   **Claim 8** is rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claim 8 of U.S. Patent No. 5,777,617. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the

method for controlling an image processing apparatus in the application is similar to the method

of controlling data a data output apparatus in the patent. For instance, the steps of receiving

image information, and storing the image information in storage in the application, reads on an

"input buffer for storing code data received from an external apparatus, an intermediate buffer

for storing intermediate data generated from the code data stored in the input buffer", (col. 8,

lines 44-48). Further, the step of outputting the image information received in the receiving step

in the application, reads on "an output buffer for storing image data generated from the

intermediate data stored in the intermediate buffer, and which outputs the image data from the

output buffer", (col. 8, lines 47-51). Also, the step of discriminating among modes used when the

image information is output in the output step, reads on the step of "determining which one of

first or second modes is set", (col. 8, lines 50-54). Finally, the step of "controlling said image

processing apparatus so that after the image information is output in accordance with the

discrimination in the discriminating step, the image information output in the output step is not

stored in said storage", reads on the step of "controlling the intermediate buffer and the output

buffer such that the image data generated at a first size designated by the external apparatus from

the intermediate data stored in the intermediate buffer is stored in the output buffer, and the

generated image data is sent from the output buffer to an output section of the data output

apparatus and thereafter the stored intermediate data is deleted from the intermediate buffer in

the event that it is determined in said determining step that the first mode is set", (col. 8, lines 54-

63).

6.   **Claim 2** is rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claim 1 of U.S. Patent No. 5,777,617. Although the

conflicting claims are not identical, they are not patentably distinct from each other because in

the application, the first mode "stores the image information received by said receiving means in

said storage means, which reads on the patent "the second mode". "the stored intermediate data

is retained in said intermediate buffer means", (col. 8, lines 10-19). Further, in the application,

the second mode, "information received by said receiving means without storing the image

information received by said receiving means in said storage means", which reads on the first

mode in the patent "thereafter the stored intermediate data is deleted from said intermediate

buffer means", (col. 7, line 66- col. 8, line 9).

7.   **Claim 9** is rejected under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claim 8 of U.S. Patent No. 5,777,617. Similar to the

reasons for the double patenting rejection of claim 2, the "first mode" in the application reads on

"the second mode" in the patent, and the second mode in the application reads on the first mode

in the patent, (col. 8, line 43-col. 9, line 5), (See the reasons given for claim 2 above).

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

8.   **Claims 1, 2, 8, 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Kishimoto,

USP 5,777,617, (hereinafter, Kishimoto), as cited by applicant.

Regarding, **claim 1,** as shown in figure 1, an image recording apparatus, which reads on

"an image processing apparatus", has a data developer unit (2) that analyzes inputted print data

and a CPU (21) generates image data recognizable by the user, which reads on "a receiving

means for receiving image information", (col. 2, lines 49-51; col. 3. lines 63-64). Further, an

image memory (25) develops the generated image data, which reads on "storage means for

storing the image information received by said receiving means", (col. 3, line 64-65). Image data

transfer is carried out on a one scan image unit basis, and the image data is transferred by using a

scan buffer (26) in response to a synch signal for the video I/F (27), which reads on "output

means for outputting the image information received by said receiving means", (col. 3, lines 27-

30). The CPU (21), further checks if the control is in test printing mode or normal printing mode,

which reads on "discriminating means for discriminating among modes used when the image

information is output by said output means", (col. 3, lines 50-51; lines 55-57). The CPU (21)

processes data in accordance with the control procedure of figures 4A, and 4B, which reads on

"control means", (col. 4, lines 45-47). After, the print mode, test mode A, B or normal, is

determined (S6), the image information is output (S15), and then deleted from page buffer (23),

which reads on "in which after the image information is output by said output means in

accordance with discrimination means, said control means performs control so that the image

information output by said output means is not stored in said storage means", (figures 4A-4B;

col. 4, lines 16-20; lines 24-27).

Regarding, **claim 2, 8, 9,** please refer to the like teachings of claim 1.

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before
the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the
requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for
patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

10.   **Claim 6, 13** is rejected under 35 U.S.C. 102(e) as being anticipated by Hayashi et al.

USP 6,426,809, (hereinafter, Hayashi).

Regarding, **claim 6,** as illustrated in figure 1, an image transmitting system, Hayashi

teaches that a transmission section (7), transmits the transmission data selected by the selection

section (6) to a public line, network line, etc, which reads on "an image communication

apparatus connectable to an image output apparatus", (col. 6, lines 44-46). A mode determination

section (14) analyzes a first image data, and a second image data and the selection data output by

the attribute separation section (11), determines whether or not each data plane contains

significant information, which reads on "determining means for determining whether or not an

image to be transmitted to said image output apparatus is a specific image", (col. 5, lines 7-11).

As shown in figure 1, a transmission section (7), is coupled to the selected data outputted by the

attribute separation section (11), that determines whether or not each data plane contains

significant information, and determines the transmission format mode, which reads on

"transmitting means for transmitting the information of the image", (col. 5, lines 10-13). As

shown in figure 8, a mode determination section of the image transmitting system, a text color

data plane is coupled to mode 0, and a background image data plane is coupled to mode 1, which

reads on "in a first format or a second format in accordance with the determination by said

determination means", (col. 10, lines 60-67).

Regarding, **claim 13,** please refer to the like teachings of claim 6.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   **Claims 3, 10** rejected under 35 U.S.C. 103(a) as being obvious over Kishimoto, USP

5,777,617, (hereinafter, Kishimoto), as applied to claim 1, and claim 8 above, and further in view

of well-known prior–art, (MPEP 2144.03).

Regarding, **claim 3,** Kishimoto fails to expressly disclose, "the image information stored

in said storage means is set so as to be overwritten", (lines 6-8).

The examiner takes Official Notice of the fact that it is well known in the art to overwrite

data using an EPROM or erasable programmable memory, or read/write memory.

It would have been obvious to anyone of ordinary skill in the art at the time of the

invention to use read/write memory because memory is widely available and inexpensive to

implement.

Regarding, **claim 10,** please refer to the like teachings of claim 3.

13.   **Claims 4, 5, 11, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kishimoto, USP 5,777,617, as applied to claim 1 and 8 above, and further in view of Teramoto,

JP 409130573, (hereinafter, Teramoto).

Regarding, **claim 4,** Kishimoto teaches all the image processing apparatus and methods

in claim 1, and 8, but fail to expressly disclose that the "discriminating means discriminates

among said modes when the image information output by said output means is to be charged or

when the image information output by said output means is not to be charged".

However, Teramoto teaches that a job processing section (35) discriminates whether the

command indicates execution or cancellation of a print, which reads on "discriminating means

discriminates among said mode", (see abstract, solution, lines 3-5). Further, this job processing

section (35), analyzes the job and a charge for execution of the job and for printing, which reads

on "when the image information output by said output means is to be charged or when the image

information output by said output means is not to be charged", (see abstract, solution, lines 3-5;

lines 10-11).

At the time the invention was made, it would have been obvious to a person of ordinary

skill in the art to modify Kishimoto's discriminating means with Teramoto's teachings of

discriminating a charge or no charge for a print job.

One of ordinary skill in the art would have been motivated to discriminate a charge or no

charge in order to depict the cancellation of a print, so that the output device does not print, given

the express suggestion of Teramoto, (see abstract, solution, lines 14-17).

Regarding, **claim 5,** Kishimoto teaches all the image processing apparatus and methods in claim 1, and 8, but fail to expressly disclose that the "discriminating means discriminates among said modes, based on an instruction from an image-information transmitter".

However, Teramoto teaches of a job processing section (35), that discriminates whether the command indicates execution or cancellation of a print, which reads on "discriminating means discriminates among said modes", based on a command received by the communication section (34), which reads on "based on an instruction from an image-information transmitter", (see abstract, solution, lines 8-10).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kishimoto's discriminating means with Teramoto's communcation section (34).

One of ordinary skill in the art would have been motivated to do use a communication section (34) across a local area network.

Regarding, **claim 11,** please refer to the like teachings of claim 4.

Regarding, **claim 12,** please refer to the like teachings of claim 5.

14.   **Claims 7, 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. USP 6,426,809, as applied to claim 6, 13 above, and further in view of Kadota, USP 6,078,399, (hereinafter, Kadota).

Regarding, **claim 7,** Hayashi teaches an image communication apparatus with determining means, and transmitting means as in claim 6 above, and claim 13, which reads on "determining means has determined that the image to be transmitted to said image output apparatus is the specific image".

Hayashi fails to expressly disclose the following: "said transmitting means transmits the information of the image in the form of a page description language, while when said determining means has determined that the image to be transmitted to said image output apparatus is not the specific image, said transmitting means transmits the information of the image in the form of bitmap data".

However, Kadota teaches that according the printer driver process of FIG. 3, the personal computer 4, transfers font data as described in the PDL language to the laser printer 2, which reads on said transmitting means transmits the information of the image in the form of a page description language". The personal computer 4 transfers all data other than the font data to the laser printer 2 as bitmap image data in the HBP format. Therefore, data of a type requiring a large amount of processing to create bitmap data, such as vector graphics described in the PDL language, is transmitted as HBP bitmap image data, which reads on "while when said determining means has determined that the image to be transmitted to said image output apparatus is not the specific image, said transmitting means transmits the information of the image in the form of bitmap data", (col. 14, lines 58-66).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Hayashi's transmitting means with Kadota's method of transmitting PDL and bitmap data.

One of ordinary skill in the art would have been motivated to do transmit PDL and bitmap image data because some data types require a lot of processing in order to convert to bitmap image data, given the express suggestion of Kadota, (col. 14, lines 60-66).

Regarding, **claim 14,** please refer to the like teachings of claim 7.

Conclusion

15.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

16   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Melanie M Vida whose telephone number is (703) 306-4220.

The examiner can normally be reached on 8:30 am 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie M Vida
Examiner
Art Unit 2626

MMV
MMV

February 19, 2004

KA Williams

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER